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Leslie Meyer-Leon, Esq.
c/o Bromberg & Sunstein LLP
125 Summer Street
11th Floor
Boston, MA 02110-1618

MAILED

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CENTRAL REEXAMINATION UNIT

In re Application of
Richard Skiffington et al.
Application No. 10/014,154
Filed: December 6, 2001
Atty. Docket No.: 0656-008US6

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: ORDER TO
: SHOW CAUSE
:
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This is a show cause order based on the expiration of U.S. Patent No. 6,180,395, for which patent the present application requests reissue.

BACKGROUND

1. Reissue application No. 10/014,154 ("the '154 reissue application") was filed on December 6, 2001, for reissue of U.S. Patent No. 6,180,395 ("the '395 patent") issued January 30, 2001.
2. The Image File Wrapper record for the '154 reissue application reveals that a Decision on Appeal was issued on October 30, 2008, and that the prosecution of the application has advanced to the point where the application is available for the Technology Center to process it after the Board decision.
3. The Office's financial records reveal that the 7.5 year maintenance fee due by January 30, 2009 (the end of the maintenance fee grace period), was not paid.
4. The '395 patent expired at midnight on January 30, 2009, for failure to pay the 7.5 year maintenance fee due.¹ Notice of the expiration of the '395 patent for failure to pay the 7.5 year maintenance fee was published on March 24, 2009, in the *Official Gazette*.²

ORDER TO SHOW CAUSE

As pointed out above, the '154 reissue application is for reissue of the '395 patent, and the '395 patent has expired for failure to pay the 7.5 year maintenance fee. A notice of

¹ See: MPEP § 2506, third paragraph.

² See: 1340 OG 162, 172 at <http://www.uspto.gov/web/offices/com/sol/og/2009/week12/TOC.htm#ref4>.

the expiration of the '395 patent was published in the *Official Gazette*. Because the '395 patent expired for failure to pay the second maintenance fee, the Director of the USPTO no longer has the authority under 35 U.S.C. § 251 to reissue the '395 patent. See *In re Morgan*, 990 F.2d 1230, 26 USPQ2d 1392 (Fed. Cir. 1993). As stated in *Morgan*,

"The language of section 251 is unambiguous: the Commissioner has authority to reissue a patent only 'for the unexpired part of the term of the original patent.' Thus, when **Morgan's original patent expired** on August 19, 1992, **the Commissioner was divested of his reissue authority** because there no longer was an unexpired term of the patent for which Morgan's patent could be reissued. Morgan's appeal thus became moot." [990 F.2d at 1231, 26 USPQ2d at 1393; emphasis added]

Because the Director no longer has the authority under 35 U.S.C. § 251 to reissue the '395 patent, the Office intends to terminate the present reissue proceeding, and thereafter hold the '154 reissue application to be an abandoned application.

Applicants are hereby provided with a period of **30 DAYS** from the mailing of this ORDER to show cause why the Office should not terminate the present reissue proceeding.

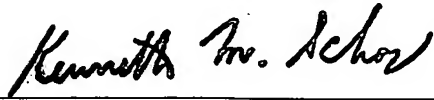
If applicants propose to show cause why the present reissue proceeding should not be terminated, applicants' showing must include an explanation of why the proceeding should continue, in spite of the expiration of the original patent.

If applicants make a showing, the showing will be evaluated as to whether it provides sufficient basis as to why the present reissue proceeding should not be terminated. A failure to respond to this show cause order within the set 30-day period will result in the proceeding being terminated by default. If the present reissue proceeding is terminated, jurisdiction over the present application for reissue of the '395 patent will be returned to Technology Center Art Unit 1797 for processing as an abandoned application.

CONCLUSION

1. Applicants are hereby provided with a period of 30 DAYS from the mailing of this ORDER to show cause why the Office should not terminate the present reissue proceeding.
2. Failure by applicants to respond to this show cause order within the set 30-day period will result in termination of the present reissue proceeding by default, followed by a mailing of a Notice of Abandonment of the '154 reissue application.
3. Jurisdiction over the '154 reissue application is being retained by the Office of Patent Legal Administration, pending a response by the applicants, or the expiration of time for a response.

4. Telephone inquiries related to this decision should be directed to Raul Tamayo, Legal Advisor, at (571) 272-7728.

A handwritten signature in black ink, reading "Kenneth M. Schor". The signature is written in a cursive, flowing style. The first name "Kenneth" is written with a large, prominent 'K'. The middle initial "M." is written in a smaller, more compact script. The last name "Schor" is written with a large, prominent 'S' and a trailing flourish.

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration